REMARKS

Claims 1-14 are pending in the application and new claims 15-20 have been added. Claims 1, 3 and 15 are independent claims. In the Office Action of May 21, 2004, claims 1, 3, 5-9 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,050,996 to Schmaltz et al. (Schmaltz '996). Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz '996. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz '996 in view of U.S. Patent No. 6,273,887 to Yamauchi et al. (Yamauchi '887). Claims 1-14 are further rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over U.S. Patent No. 6,517,536 in view of Schmaltz '996.

In response to the Office Action, certain claims have been amended, where necessary, to further clarify the features recited in the claims. Each of claims 1, 3 and 15 recite, in part, that each jaw has at least three distinct elements, an elongated support member supporting substantially the entire length of its associated conductive ablation member, the elongated conductive ablation member of the respective jaw and an insulator between them. Claim 1 has been amended to include that each jaw further comprises opposed clamping surfaces and each clamping surface comprises an insulating material. These features are also recited in claims 3 and 15. Such features are fully supported by the specification and

clearly shown, for example, in Figure 32. Figure 32 is a cross-sectional view of the jaws showing a structural support 82 (a support member), insulating members 84, 86 and 88 (an insulating material and insulator) and electrodes 94, 96 (conductive ablation members). Such features are described beginning at page 22 in paragraph 107 in the present application.

The cited reference to Schmaltz '996 does not disclose or suggest the subject matter of claims 1, 3 and 15. The apparatus disclosed in Schmaltz '996 has a very different structure at each of its jaws 19 and 20. The jaws 19 and 20 include first and second electrodes 11 and 12 respectively. Each of the first and second electrodes 11 and 12 has an electrically conductive seal surface 24 and an electrically insulative substrate 25, as shown in Figures 5 and 7. In Figures 2 and 3, the clamping surface of each jaw is comprised essentially entirely of the respective electrode 11 and 12. Indeed, the electrode 12, in Figure 2, is basically as wide as the entire jaw (column 4, lines 24-25). Figures 8 and 10 show only a slight marginal edge that is not actually part of the clamping surface. Schmaltz '996 does not teach or suggest a clamping surface which is comprised of an insulating material. Rather, the clamping surface comprises the electrically conductive seal surface 24. The insulative substrate 25 is positioned away from each jaw's clamping surface so as to attach each electrode 11 and 12 to its respective jaw 19 and 20.

For these reasons, each claims 1, 3 and 15 are believed to be distinguishable over the cited reference to Schmaltz '996. As such, applicant respectfully submits that claims 1, 3 and 15 are not anticipated or obvious by Schmaltz '996, and thus are allowable. Each of the remaining claims 2, 4-14 and 16-20 is dependent either directly or indirectly from one of claims 1, 3 and 15 and is thus also believed to be allowable.

Turning to the rejection for double patenting over U.S. Patent No. 6,517,536 in view of Schmaltz '996, applicants respectfully request reconsideration because it is believed that the grounds for rejection do not represent an instance where a double patenting issue can be raised. According to MPEP Section 804 I.A., an instance double patenting may exist between an issued patent and an application filed by the same inventive entity. The MPEP does not describe an instance of double patenting being raised where the grounds for rejection are based on an issued patent filed by the same inventive entity in combination with another patent not owned by the same inventive entity, which is the instance described in the Office Action. The Office Action includes a double patenting rejection which is based on an issued patent owned by the same inventive entity in combination with Schmaltz '996, a patent owned by a different inventive entity. The inventor and assignee of the present invention, Michael D. Hooven and AtriCure, Inc., respectively, are the same as those of the U.S. 6,517,536 patent,

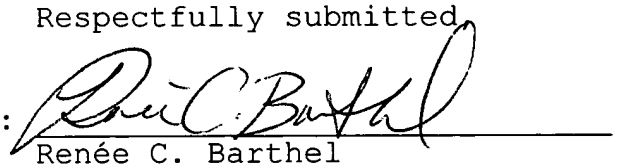
but are not the same as the applicant or inventor of Schmaltz '996 (Dale Francis Schmaltz, Robert Luzzi, David Nichols Heard, Steven Paul Buysee, Kate Ryland Lawes, Daniel Lee Trimberger, II, Mathew Erle Mitchell, Jennifer Serafin Kennedy and Sherwood Services AG). Therefore, applicants respectfully request the Examiner withdraw this rejection.

INFORMATION DISCLOSURE STATEMENTS

Applicant also requests that the references cited in applicants' Information Disclosure Statements mailed December 4, 2003, April 1, 2004, May 6, 2004 and June 15, 2004, be considered and made of record in this application and initialed copies of the listing of references be returned to the applicant. For the Examiner's convenience, applicants have enclosed copies of each PTO/SB/08A form which has been mailed with these Information Disclosure Statements in the event such forms have not yet reached the Examiner. Copies of the documents listed on these forms have been previously mailed. However, additional copies of these references can be mailed at the Examiner's request.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,

Date: August 20, 2004 By: 

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